



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

SEP 15 2006

DUANE MORRIS, LLP  
380 LEXINGTON AVENUE  
NEW YORK, NY 10168

In re Application of :  
John Hamilton :  
Serial No.: 09/851,230 : PETITION DECISION  
Filed: May 8, 2001 :  
Attorney Docket No.: E1679-00007 :

This is in response to the petition under 37 CFR 1.181, filed May 30, 2006, requesting the Office to determine the priority date of a reference.

#### BACKGROUND

Applicant requests the Office to determine the correct or proper priority date of a reference cited against the above identified application under 35 U.S.C. 102(e) in the last Office action mailed March 28, 2006. US Patent Application Publication No. US2002/0141994 to Devalaraja et al based on SN 09/885,259, filed February 23, 2001, was published on October 3, 2002, and will mature into US Patent 7,108,852 on September 19, 2006. SN 09/885,259 was originally filed as a provisional application on February 23, 2001 and was assigned SN 60/270,948 and consisted of a specification, claims and drawings, as required for a complete application, but lacked a declaration of the inventors. The provisional application contained no priority claim. On July 9, 2001, applicants filed a petition in SN 60/270,948 to convert the application to a non-provisional application and included an amendment to the specification to claim priority to an earlier provisional application, SN 60/190,842, filed March 20, 2000. The petition to convert was granted on September 5, 2001. The original filing receipt issued by the Office did not include the priority claim, but a later corrected filing receipt did. Applicant requests that the priority date accorded the publication be that of its filing date, February 23, 2001.

#### DISCUSSION

Applicant argues that the '994 publication cannot have an earlier priority date than the date of its filing and the claim of priority to an earlier provisional application is invalid. Applicant's first argument is to the effect that a provisional application cannot claim priority to any other earlier filed application. This is correct. The '994 when filed as a provisional application did not and could not have a priority claim to any other application. It is duly noted that the two provisional applications were copending for approximately four weeks before SN 60/190,842 became abandoned by operation of law one year from its date of filing. SN 60/270,948 was a proper provisional application as of its date of filing. However, upon conversion to a non-provisional

application on September 5, 2001, it became a non-provisional application having the same filing date as the provisional application since the provisional application was a complete application under 35 U.S.C. 111(a), except for the missing declaration. An application filed under 35 U.S.C. 111(a) should include a priority claim when filed, however applicants are give a period of four months from date of filing or 16 months from earliest priority date claimed, to insert a proper priority claim without penalty. Applicants complied with these provisions by inserting a priority claim at the time of filing the petition for conversion to a non-provisional application. The priority claim was proper since both applications were copending for at least a brief period of time and it was made within the time periods set in the Rules of Practice. Thus a priority date of March 20, 2000, for the subject matter supported by SN 60/190,842 is proper and the reference is properly applied under 35 U.S.C. 102(e).

While applicant argues that 35 U.S.C. 119(e) provides domestic priority for applications filed under 35 U.S.C. 111(a) within one year of the filing date of the provisional application, and that the later application was not a non-provisional application until after that one year period had passed, the conversion of a provisional application to a non-provisional application acts to provide the converted application with a non-provisional filing date which is the same as the original provisional filing date. Thus the requirements of 35 U.S.C. 119(e) are satisfied.

Note, if applicants had filed the '994 publication as a non-provisional application on February 23, 2001, without a priority claim and then inserted a priority claim on July 9, 2001, the claim would have been considered proper by applicant and no argument would have been made.

Applicants also argue the provisions of the Paris Convention Treaty provide for only 12 months (one year) of foreign priority and that the above scenarios could, in effect, provide for up to two years of foreign priority. However, foreign priority is not at issue here, only domestic priority and applicants' arguments are considered moot since the Treaty does not apply to domestic priority.

## DECISION

The petition is **DENIED**. The '994 publication is correctly accorded a priority date of March 20, 2000, and is correctly applied under 35 U.S.C. 102(e).

**Applicant remains under obligation to reply to the Office action mailed March 28, 2006, within the time period set therein, or as extended under 37 CFR 1.136(a).**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



John L. LeGuyader

Director, Technology Center 1600